

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re application of:	Art Unit:	1631
Karen L. FINCHER <i>et al.</i>	Examiner:	Channing Mahatan
Appn. No.: 09/666,355	Atty. Dkt. No.:	16517.314
Filed: September 20, 2000	Appeal No.:	2004-1034
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants		

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**Request for Suspension of Appeal**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.<sup>1</sup>

On October 23, 2002 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on December 20, 2002 and waived oral hearing on July 22, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

<sup>1</sup> Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

I hereby certify that the foregoing Request for Suspension of Appeal is being facsimile transmitted to the attention of the Board of Patent Appeals and Interferences, via facsimile number (703) 308-6200, and to the U.S. Patent and Trademark Office Central facsimile number (703) 872-9306.

August 20, 2004  
Date

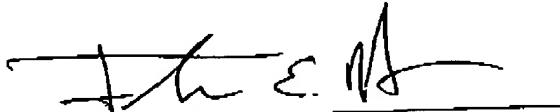
Karen L. FINCHER *et al.*  
Ser. No. 09/666,355  
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No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.<sup>2</sup>

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8<sup>th</sup> Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



Date: August 20, 2004

Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)  
ARNOLD & PORTER LLP

Of Counsel

Lawrence M. Lavin, Jr. (Reg. No. 30,768)  
Thomas E. Kelley (Reg. No. 29,938)  
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<sup>2</sup> The Board has upheld Examiners' utility rejections in similar appeals. *See, e.g.* Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

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**ARNOLD & PORTER LLP**

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<b>MESSAGE</b>		

Re: Appeal Nos. 2003-1072, 2003-1073, 2003-1074, 2003-1666, 2003-1939, 2004-1034, 2004-1272,  
 2004-1273, 2004-1275, 2004-1406, 2004-1480, 2004-1725, 2004-1773 and  
 Application No. 09/267,199 (BHAT *et al.*) filed March 12, 1999 (Conf. No. 6701)

Atty. Dkt. Nos.: 16517.323, 16517.326, 16517.324, 16517.128, 16517.277,  
 16517.314, 16517.032, 16517.285, 16517.276, 16517.272,  
 16517.281, 16517.231, 16517.142 and 16517.233

See the attached. Please acknowledge receipt via return facsimile.

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August 20, 2004

VIA FACSIMILE

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: Requests for Suspension of Appeal

Dear Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office is a Request for Suspension of Appeal for each of the following applications:

1. Appeal No.: Not Yet Assigned/Conf. No. 6701  
Serial No. 09/267,199, filed March 12, 1999  
Applicants: Barkur G. BHAT *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tocopherol Pathway  
Attorney Docket No.: 16517.233
2. Appeal No.: 2003-1072  
Serial No. 09/333,534, filed June 14, 1999  
Applicants: Timothy W. CONNER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.323
3. Appeal No.: 2003-1073  
Serial No. 09/540,234, filed April 3, 2000  
Applicants: Timothy W. CONNER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.326
4. Appeal No.: 2003-1074  
Serial No. 09/552,086, filed April 19, 2000  
Applicants: Robert E. BUEHLER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.324
5. Appeal No.: 2003-1666  
Serial No. 09/521,640, filed March 10, 2000  
Applicants: Joseph R. BYRUM *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.128

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**ARNOLD & PORTER LLP**

Board of Patent Appeals and Interferences

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6. Appeal No.: 2003-1939  
Serial No. 09/333,535, filed June 14, 1999  
Applicants: Joseph R. BYRUM *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.277
7. Appeal No.: 2004-1034  
Serial No. 09/666,355, filed September 20, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.314
8. Appeal No.: 2004-1272  
Serial No. 09/371,146, filed August 9, 1999  
Applicants: Nordine CHEIKH *et al.*  
Title: Annotated Plant Genes  
Attorney Docket No.: 16517.032
9. Appeal No.: 2004-1273  
Serial No. 09/637,086, filed August 11, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.285
10. Appeal No.: 2004-1275  
Serial No. 09/540,235, filed April 3, 2000  
Applicants: Dane K. FISHER *et al.*  
Title: Nucleic Acid Sequences from Cyanidium Caldarium and Uses Thereof  
Attorney Docket No.: 16517.276
11. Appeal No.: 2004-1406  
Serial No. 09/553,094, filed April 18, 2000  
Applicants: Scott E. ANDERSEN *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.272

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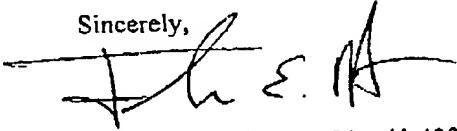
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12. Appeal No. 2004-1480  
Serial No. 09/732,627, filed December 8, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.281
13. Appeal No.: 2004-1725  
Serial No. 09/233,218, filed January 20, 1999  
Applicants: Claire A. CAJACOB *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole Pathway  
Attorney Docket No.: 16517.231
14. Appeal No.: 2004-1773  
Serial No. 09/421,106, filed October 15, 1999  
Applicants: Joseph R. BYRUM  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.142

It is respectfully requested that acknowledgement of receipt of these waivers be sent via return facsimile to the undersigned at 202-942-5999.

In the event that extensions of time are necessary to prevent abandonment of these patent applications, then such extensions of time are hereby petitioned. Appellants do not believe any fees are due in conjunction with these filings. However, if any fees are required in the present applications, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.001.

Sincerely,



David R. Marsh (Reg. No. 41,408)  
Thomas E. Holsten (Reg. No. 46,098)

Enclosures